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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,957	07/14/2003	Mitsushi Yamamoto	UNI79.013AUS	6418

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EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

NOTIFICATION DATE	DELIVERY MODE
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01/10/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/618,957	Applicant(s) YAMAMOTO ET AL.	
	Examiner Nasser Ahmad	Art Unit 1772	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

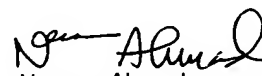
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112, first paragraph.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 8-12.
Claim(s) withdrawn from consideration: 13.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.


Nasser Ahmad
Primary Examiner
Art Unit: 1772
1/8/07

Continuation of 11. does NOT place the application in condition for allowance because: In response to applicant's argument made in the amendment filed on 12/21/2006 regarding the AU 9640808A reference, applicant should note that AU'808A, claim 10, recites that a magnetic recording layer and/or a printing ink layer is present on at least A PART OF THE SURFACE (and not on the whole surface as alleged by the applicant as "without exception").

For the film being transparent, applicant has correctly noted that the preferred embodiment is directed to a white polyester film. However, it is also noted that nowhere does the reference AU'808A recite that the film is "non-transparent" as contended by the applicant. Further, applicant should note that the instant claims does not specify the DEGREE OF TRANSPARENCY of the claimed protective film. In other words, the claim fails to teach if the transparency is 100% or 1% and, in the absence of such a teaching, the protective film of AU'808A is found to be transparent and reads on the invention as claimed.

Regarding Malhotra, applicant argues that the reference does not disclose an antistatic layer comprising polymers having pyrrolidinium rings in their main chains. This is not found to be persuasive because Malhotra clearly teaches that the antistatic pyrrolidinium ring structure in col. 30 and discloses that the radical R can include carbon atom of 20 or 30, which is taken to be the polymer chain. This should obviate applicant's concern that "it is difficult to point out that which is absent" because Malhotra does teach the pyrrolidinium ring in the main chain of the polymer as explained hereinabove.

For claim 12, applicant is directed to Malhotra, col. 7, lines 9-10, which recites that the "polyesters such as Mylar®", and it is well known in the art that Mylar® is polyethylene terephthalate.

For claims 10 and 11, applicant is directed to the last Office Action of 9/22/2006, paragraph-12 because the thickness of adhesive can be of 1 micron but can also be of any thickness. As for AU'808A mentioning that thicker than 1 micron, the adhesive lubricity deteriorates unfavorably, applicant should note that it does not state that the higher thickness is not possible. Similarly, Malhotra teaches "preferable....thickness of 0.5 microns or less", which is directed to a preferred embodiment therein .